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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,398	04/30/2005	Charles C. Hart	2395-USP-PCT-US	9071

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APPLIED MEDICAL RESOURCES CORPORATION  
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EXAMINER
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NEAL, TIMOTHY J

ART UNIT	PAPER NUMBER
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3731

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/533,398

Applicant(s)

HART, CHARLES C.

Examiner

Timothy J. Neal

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) 1-21 and 39-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 22-28 and 44-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This action is in response to the amendment received on 12/22/2006. Claims 1-28 and 39-49 are pending. Claims 29-38 have been canceled. Claims 1-21 and 39-43 have been withdrawn from consideration as being directed to non-elected inventions.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 22-28 and 44-49** are rejected under 35 U.S.C. 102(b) as being anticipated by Hart et al. (US 6,139,555).

Hart discloses:

22. An applier, the applier comprising: an elongate shaft having a proximal end and a distal end (Fig 1 Item 12); a pair of opposed jaws connected at the distal end of the elongate shaft (Fig 1 Item 30); a handle operably connected at the proximal end of the elongate shaft to open and close the opposed jaws (Fig 1 Items 50 and 52); and a sliding member operably connected within the elongate shaft to advance the securing member over the first and the second tissue-engaging members after closure of the jaws (Fig 1 Item 56).

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23. The applier of claim 22, wherein the jaws operate to apply the first and the second tissue-engaging members around a target body tissue or vessel (Col 2 Line 52).

24. The applier of claim 23, wherein the first and the second tissue-engaging members are applied to the jaws either manually or automatically (Fig 4).

25. The applier of claim 23, wherein the jaws are compressed using only a force required for a specific surgical procedure such as occlusion, ligation or fixation (Col 2 Line 40).

26. The applier of claim 25, wherein the first and the second tissue-engaging members and the securing member are introduced to a surgical site in an un-assembled condition through a small port or trocar (Col 2 Line 22).

27. The applier of claim 26, wherein the sliding member operates to urge the securing member forward and over the first and second tissue-engaging members to secure the medical device (inherent, see Col 3 Line 25).

28. The applier of claim 27, wherein the applier and the medical device are sized and configured for use in a minimally invasive or laparoscopic surgical procedure (Col 2 Line 22).

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44. The applier of claim 22, wherein the elongate shaft is sized to fit through a surgical trocar port (Col 2 Line 22).

45. The applier of claim 45 wherein one of the jaws has a first slot arranged to operably receive the first tissue engaging member without the securing member and another of the jaws has a second slot arranged to operably receive the second tissue engaging member without the securing member (Fig 2 Item 38).

46. The applier of claim 45 wherein the first slot is arranged to operably receive a first portion of the securing member and the second slot is arranged to operably receive a second portion of the securing member, the first and second portions of the securing member being different (Fig 2 Item 38).

47. The applier of claim 22 wherein one of the jaws has a first slot sized and arranged to simultaneously hold the first tissue engaging member and a first portion of the securing member and another of the jaws has a second slot arranged to simultaneously hold the second tissue engaging member and a second portion of the securing member (Fig 2 Item 38).

48. An applier for applying a medical device to constrict or occlude a body tissue or vessel, the applier comprising: an elongate shaft (Fig 1 Item 12) having a proximal end and a distal end; a pair of opposed jaws (Figure 1 Item 30) connected at the distal end

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of the elongate shaft and arranged to open and close; and a sliding member (Fig 1 Item 56) operably connected within the elongate shaft to advance a securing member of a staple-clip over a first tissue-engaging member of the staple-clip and a second tissue-engaging member of the staple-clip after closure of the jaws, the sliding member separable from the securing member of the staple-clip and the first and second tissue-engaging members of the staple-clip with the securing member separable from the first and second tissue-engaging members; wherein a first jaw of the pair of opposed jaws is arranged to hold the first tissue- engaging member of the staple-clip, the first jaw being separable from the first tissue- engaging member of the staple-clip; and a second jaw of the pair of opposed jaws is arranged to hold the second tissue- engaging member of the staple-clip, the second jaw being separable from the second- tissue engaging member of the staple-clip.

49. The applier of claim 48 wherein the first jaw of the pair of opposed jaws holds the first tissue engaging member of the staple-clip without the securing member of the staple-clip and a first jaw of the pair of opposed jaws holds the second tissue engaging member of the staple-clip without the securing member of the staple-clip.

### ***Response to Arguments***

The objection to the drawings has been removed. The 35 USC 112 rejection has been removed upon further consideration and in light of the Applicant's remarks on pages 13 and 14.

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Applicant's arguments filed 12/22/2006 have been fully considered but they are not persuasive.

The Applicant has argued that Hart does not disclose a staple clip as claimed. The Examiner notes that no staple clip has been claimed. Claim 22 is directed to an applier, not a staple clip. The preamble of claims 22 and 48 clearly identify the claimed invention as an applier. The restriction requirement clearly identified the inventions as subcombinations usable together. Claims 22 and 48 are subcombination claims, not combination claims. Also, the Examiner considers the prior action to be consistent with the present interpretation because the Examiner did not address the staple clip. Only the applier was addressed because the staple clip is not part of the applier. The Hart reference does not need to recite the staple clip described, it only needs to be capable of being used with the staple clip. All other arguments are based on the Hart reference not disclosing the staple clip as claimed. The Applicant has not argued that any structural limitations of the Hart reference fail to anticipate the claimed subject matter directed to the applier. Therefore, the Examiner considers the reference to read on the claims.

The Applicant has also addressed the operation of the Hart reference. The Examiner considers the Hart reference capable of performing the functions as claimed, and the reference does not need to explicitly state these operations. The intended use of the claims does not overcome the prior art.

Furthermore, claims 23-27 are drawn entirely to functional language claiming limitations that do not further limit the structure of the applier. The Hart reference is capable of performing the functions and operations claimed.

In conclusion, the Examiner considers the Hart reference capable of being used with the described staple clip. The slots 38 can hold the tissue-engaging members and the sliding member 56 can be used to advance a securing member over the tissue-engaging members. The tissue-engaging members and the securing member have not been claimed and are not considered to be part of the applier as claimed. Language such as "arranged to" and "operate to" does not further limit the structure of the applier and is given little patentable weight. The Examiner does not consider these functional limitations to overcome the prior art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy J. Neal whose telephone number is (571) 272-0625. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TJN

  
**ANH TUAN T. NGUYEN**  
**SUPERVISORY PATENT EXAMINER**  
2/1/07.